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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,506	08/09/2000	Scott Faber	004704.P004	5692

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08/18/2003

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,506

Applicant(s)

FABER ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17. 6) ☐ Other: _____

DETAILED ACTION

1. This Non-Final Office action is responsive to Applicant's after-final response filed July 7, 2003.

No amendments have been made to the claims.

Claims 1-96 are pending.

Response to Arguments

2. Applicant's arguments filed July 7, 2003 properly invoke the 35 U.S.C. § 103(c) exception; therefore, the previously pending art rejection is withdrawn. Additionally, finality of the previous Office action is withdrawn. New rejections are presented below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Expertcity.com's Internet service, as disclosed in "Expertcity.com Launches Premier Online Marketplace for Expert Services" (which states that the Expertcity.com web site was launched on August 30, 1999) and "Rent-An-Expert on the Web," in view of Weinstein et al. (US 2001/0026609 A1).

Expertcity.com discloses a method comprising:

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[Claim 1] displaying a service provider and a service provider rate for communicating with the service provider and a real-time indication of whether the service provider is available ("Rent-An-Expert on the Web": ¶¶ 3, 4, 6 -- Experts who respond with bids are deemed to be currently available to assist the customer);

receiving a request from a first customer to communicate with the service provider ("Rent-An-Expert on the Web": ¶ 3);

connecting the first customer to the service provider through a link capable of transmitting from the service provider to the first customer ("Rent-An-Expert on the Web": ¶ 4);

receiving a request from a second customer to communicate with the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4, 6 -- As long as the expert stays online and he/she is deemed to be available, he/she connects with customer after customer one at a time, i.e., a first customer, second customer, etc.; therefore, it is understood that the expert is connected to a customer any time the expert is online and a customer desires to communicate with him/her); and

connecting the second customer to the service provider through a link capable of transmitting from the service provider to the second customer ("Rent-An-Expert on the Web": ¶¶ 3, 4, 6 -- As long as the expert stays online and he/she is deemed to be available, he/she connects with customer after customer one at a time, i.e., a first customer, second customer, etc.; therefore, it is understood that the expert is connected to a customer any time the expert is online and a customer desires to communicate with him/her);

billing the first customer automatically based on the time during which the link to the first customer is maintained ("Rent-An-Expert on the Web": ¶ 6); and

billing the second customer automatically based on the time during which the link to the second customer is maintained ("Rent-An-Expert on the Web": ¶ 6 -- As long as the expert stays online and he/she is deemed to be available, he/she connects with customer after customer one at a time, i.e., a first customer, second customer, etc.; therefore, it is understood that the expert is connected to a customer any time the expert is online and a customer desires to communicate with him/her);

[Claim 3] wherein the link from the service provider to the first customer is implemented through use of the Internet ("Rent-An-Expert on the Web": ¶ 2);

[Claim 4] wherein the link from the service provider to the first customer is configured to transmit from the first customer to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 5] the first customer paying an intermediary and the second customer paying the intermediary, the intermediary receiving the requests, the intermediary connecting the service provider to the first customer, the intermediary connecting the service provider to the second customer, the intermediary performing the billing ("Rent-An-Expert on the Web": ¶ 6 -- Expertcity.com connects the customers and the experts and keeps "an undisclosed percentage of the fee," thereby implying that the billing goes through Expertcity.com);

[Claim 6] the intermediary having a set of service providers including the service provider ("Rent-An-Expert on the Web": ¶ 2); and

the intermediary performing the providing in response to a choice by the first customer of the service provider from the set of service providers ("Rent-An-Expert on the Web": ¶ 4);

[Claim 7] wherein the link from the service provider to the first customer is implemented through use of the Internet or through use of telephone connections ("Rent-An-Expert on the Web": ¶ 2);

[Claim 8] wherein the link from the service provider to the first customer is configured to transmit from the first customer to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 9] moderating transmissions from the service provider and transmissions from the first customer ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 10] wherein the moderating is performed by the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 11] wherein the moderating is performed by a moderator ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 12] further comprising the moderator receiving a request from the first customer to transmit to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 19] wherein the request from the first customer to transmit to the service provider pertains to transmitting a question to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 21] receiving a request from the second customer to transmit a question to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

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[Claim 23] removing the first customer from the link between the first customer and the service provider, the removing performed by the moderator ("Rent-An-Expert on the Web": ¶¶ 3, 4 -- It is understood that the connection is ended when either the expert, customer, or server hangs up/disconnects).

As per claim 1, Expertcity.com teaches an expert system wherein multiple customers (one-at-a-time) can pay to communicate with an expert, i.e., a service provider; however, Expertcity.com fails to explicitly teach the connection of both a first and second customer to a service provider at the same time. Weinstein makes up for this deficiency in his teaching of "group expert calls" (¶¶ 112, 115). An expert offers a scheduled time during which various customers can pay for the opportunity to participate in a group call with the expert. These group expert calls "facilitate the more equitable marketing of people's time on the phone" (¶ 25), thereby providing an easily accessible forum for experts to market their revenue-generating services. Both Expertcity.com and Weinstein provide readily accessible forums where experts can market their services to the public; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement Weinstein's group expert call feature with Expertcity.com's expert system such that an expert can consult with both a first and second customer at the same time in order to facilitate the more equitable marketing of the experts' time on the phone, thereby providing an easily accessible forum for experts to market their revenue-generating services.

Regarding claims 2, 14-16, and 18, Expertcity.com fails to expressly teach that the customers may converse with an expert, such as through the use of telephone connections. However, Official Notice is taken that it is old and well-known in the art of communications to enhance Internet communications with voice capabilities so that two users connected via the Internet can converse with one another. Furthermore, many Internet users connect to the Internet through a modem that dials up to the Internet through a telephone line. These voice capabilities via the Internet (and ultimately through a telephone line) reap the benefits of facilitating oral communications, which in and of themselves are more efficient timewise for conveying ideas than written communications, at cheaper rates (as compared to making a long-distance call directly through the telephone). Expertcity.com performs the generic functionality (e.g., connecting the customers to experts, receiving payment based on the connection time, etc.) of claims 2, 14-16, and 18 (see "Rent-An-Expert on the Web": ¶¶ 3, 4, 6; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enhance Expertcity.com's generic functionality (e.g., connecting the customers to experts, receiving payment based on the connection time, etc.) corresponding to claims 2, 14-16, and 18 with voice capabilities so that two users connected via the Internet can converse with one another through telephone lines in order to reap the benefits of facilitating oral communications, which in and of themselves are more efficient timewise for conveying ideas than written

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communications, at cheaper rates (as compared to making a long-distance call directly through the telephone).

As per claims 13 and 20, Expertcity.com permits the first customer to transmit a question to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4). The customer is charged based on the time connected to an expert ("Rent-An-Expert on the Web": ¶ 6); however, Expertcity.com fails to expressly teach other variations of payment requirements, such as receiving payment from the customer for transmitting a question to the service provider (as per claim 20) and allowing the customer to contact the service provider upon payment to the intermediary (as per claim 13). Official Notice is taken that it is old and well-known in the art to charge a customer on a per-service basis. For example, service providers often assess service fees to encourage customers to consolidate service requests, thereby allowing the service providers to more efficiently plan for and provide their services to various customers. Further, Official Notice is taken that it is old and well-known in the art to request payment before services are rendered in order to help ensure that a service provider is adequately and timely paid for services rendered. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with Expertcity.com the step of receiving payment from the customer for transmitting a question to the service provider (as per claim 20) in order to encourage customers to consolidate service requests, thereby allowing the service providers to more efficiently plan for and provide their services to various customers. Further, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the

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time of Applicant's invention to implement with Expertcity.com the step of allowing the customer to contact the service provider upon payment to the intermediary (as per claim 13) in order to help ensure that a service provider is adequately and timely paid for services rendered.

Furthermore, as per claims 17 and 22, Weinstein discloses a waiting list feature with his group expert call system (§ 115). This feature allows new participants to enter a group expert call when other participants disconnect, thereby increasing profit for an expert who is charging each participant by the minute. Expertcity.com teaches that customers are charged per minute of connection time ("Rent-An-Expert on the Web": § 6); therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize Weinstein's waiting list feature to enable Expertcity.com's moderator to queue requests to converse with the service provider (as per claim 17) as well as requests to transmit questions to the service provider (as per claim 22) in order to allow new participants to enter a group expert call when other participants disconnect, thereby increasing profit for an expert who is charging each participant by the minute.

[Claims 24-46] Claims 24-46 recite limitations already addressed by the rejection of claims 1-23 above; therefore, the same rejection applies.

[Claims 47-60] Claims 47-60 recite limitations already addressed by the rejection of claims 1-23 above; therefore, the same rejection applies.

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[Claims 61-74] Claims 61-74 recite limitations already addressed by the rejection of claims 1-23 above; therefore, the same rejection applies.

[Claims 75-96] Claims 75-96 recite limitations already addressed by the rejection of claims 1-23 above; therefore, the same rejection applies.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-96 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No.

6,223,165 in view of Weinstein et al. (US 2001/0026609 A1). The rejection under 35 U.S.C. § 103(a) found in Paper No. 15 sets forth the differences between the claimed invention in U.S. Patent No. 6,223,165 and the instantly claimed invention and why such differences are deemed to be obvious variants over one another.

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7. Claims 1-96 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 6,523,010 in view of Weinstein et al. (US 2001/0026609 A1). The rejection under 35 U.S.C. § 103(a) found in Paper No. 15 sets forth the differences between the claimed invention in U.S. Patent No. 6,223,165 (whose claims recite limitations similar to those recited in claims 1-47 of U.S. Patent No. 6,523,010) and the instantly claimed invention and why such differences are deemed to be obvious variants over one another.

8. Claims 1-96 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,546,372 in view of Weinstein et al. (US 2001/0026609 A1). The rejection under 35 U.S.C. § 103(a) found in Paper No. 15 sets forth the differences between the claimed invention in U.S. Patent No. 6,223,165 (whose claims recite limitations similar to those recited in claims 1-37 of U.S. Patent No. 6,546,372) and the instantly claimed invention and why such differences are deemed to be obvious variants over one another.

9. Claims 1-96 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,549,889 in view of Weinstein et al. (US 2001/0026609 A1). The rejection under 35 U.S.C. § 103(a) found in Paper No. 15 sets forth the differences between the claimed invention in U.S. Patent No. 6,223,165 (whose claims recite limitations similar to those

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recited in claims 1-41 of U.S. Patent No. 6,549,889) and the instantly claimed invention and why such differences are deemed to be obvious variants over one another.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

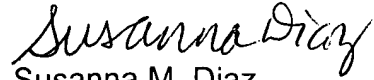
or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz
Primary Examiner
Art Unit 3623
August 12, 2003